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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,811	09/05/2003	Carey E. Garibay	BEAS-01454US2	7109
23910 7590 04/15/2008 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108				
EXAMINER				
JOHNS, CHRISTOPHER C				
ART UNIT		PAPER NUMBER		
3621				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/655,811

**Applicant(s)**

GARIBAY ET AL.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 2/27/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Acknowledgements***

1. Claims 1, 10, 11, 17, and 20-30 have been amended.
2. Claims 1-30 have been examined.
3. The Examiner in this case has changed to Christopher Johns. Please address all future correspondence to Examiner Johns, whose contact information is at the end of this Action.

### ***Claim Objections***

4. Claims 2, 3, 5, 6, 7, 12, 13, 15, 16, 17, 22, 23, 25, 26, and 27 are objected to because of the following informalities:
  - a. Claims 2, 3, 5, 6, 12, 13, 15, 16, 22, 23, 25, and 26 contain no positive recitation – instead, they note that the access rules *can* be set to do certain things or *can* be used to allow certain things. It has been held that language that suggests or makes something optional does not limit the scope of a claim or limitation. See MPEP 2106 II C.
  - b. Similarly, claims 7, 17, and 27 contain language that note that a group administration application is *adapted to allow* the production of reports. The Examiner notes that this limitation may be read as an optional one. Again, see MPEP 2106 II C, as well as the case law cited in the immediately previous action.
  - c. The Examiner also notes the definition of "allow" (from Webster's New Basic Dictionary): "to permit". Anything that does not actively prevent

an action from taking place can be said to "allow" said action. (For example, were the administration application to actively prohibit the production of reports, it would then be said to not "allow" production). This, too, seems like an optional limitation.

5. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. As per claims 21-30, it is unclear whether Applicants are claiming the subcombination of a digital record which indicates rights associated with licenses, or the combination of a digital record and a computer readable medium containing instructions.

9. If Applicants' intent is to claim only the subcombination of the digital record, the body of the claims must be amended to remove any positive recitation of the combination. If Applicants' intent is to claim the combination, then the preamble of the claim must be amended to be consistent with the language in the body of the claim.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2004/0158709 (hereafter "Narin"), in view of Microsoft Windows Media Player.

12. As per claims 1-30, Narin claims:

13. maintaining digital records of software licenses for multiple groups (§136 – "a directory lists for each requestor not only the identifier thereof but also the identifier of each group/cluster/division/platform/other entity/etc. that the requestor is a member of"), the digital records indicating rights (Figure 3, reference number 308) associated with software licenses (Figure 3, reference number 310);

14. accessing a group administration application to set access rules for members of a group, controlling access of digital record data of the group by members of the group (§119 – "In such a situation...a rights template is created that the user can repeatedly employ in connection with creating rights labels...[to apply to sets] of users or classes..."; §123 – "rights template may be used to limit the scope or type of rights labels that can be created....may be pre-defined as policy that a particular user should always publish content to a particular class of users only...");

15. using access rules to determine whether to allow a member of the group to view digital record data (inherent in the art of digital rights management, as this allows the system to protect the data it attempts to protect; also see ¶60 - "a content owner...wishes to restrict what the user can do with such distributed digital content...may wish to restrict the user from copying and re-distributing such content to a second user..."; ¶62 - "allows an owner of digital content to specify license rules that must be satisfied before such digital content is allowed to be rendered on a user's computing device..."; finally, see generally ¶48, ¶49, ¶58-67, ¶71, and ¶72);

16. when the member is allowed to view the digital record data, displaying the data including displaying a right associated with one of the software licenses (Narin does not explicitly disclose that a member allowed to view the digital record data is also able to see the rights associated with the license. Microsoft Windows Media Player discloses a way for users to view the rights that have been granted – see "Microsoft Windows Media – Troubleshooting Windows Media Player 9 Series Error Messages" (hereafter WMP), subheading "C00D2720: Cannot copy the file". WMP teaches this to allow users to know which rights that they are afforded for any file. This allows the user to understand what he may and what he may not do with said file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention in Narin to allow users to view the rights they are afforded (as in WMP) because it would allow a more usable and convenient system for the users. Allowing users to know which rights they have in a certain

file has the advantage of allowing users to understand which files may be copied and which may not be copied – a person having ordinary skill in the art would appreciate this as an advantage because it enables a more informative system);

17. access rules can be set to allow some group members to see but not modify software license data (§110 – “the SRL can be republished if the user of the content has been granted sufficient permission to do so. That is, if allowed, the user may alter rights data within the SRL...”);

18. access rules can be set to restrict access based on inputted field information (figure 12, reference numbers 1202, 1204);

19. selected access rules can allow a group member to access a digital record and adjust the rights associated with the software license (§110 – “the SRL can be republished if the user of the content has been granted sufficient permission to do so. That is, if allowed, the user may alter rights data within the SRL...”);

20. group administration application is adapted to allow production of reports concerning software licenses of the group (claim 25, “locating the listing for the group in the directory based on the identifier of the group...”);

21. configuration information for the computers running software associated with the software licenses are stored in the digital records (figure 11, reference numbers 13, 16, “rules and requirements”).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- d. Internet Archive's Wayback Machine archive of "Windows Media Download Center", from April 2003.
- e. US Patent 6,226,618 B1 (Downs et al), especially Figures 1 and 2.
- f. "Microsoft Announces Windows Rights Management Services (RMS)", story from 25 February 2003, obtained from Coverpages.org.

23. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns  
Examiner  
Art Unit 3621

CCJ

/ANDREW J. FISCHER/  
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